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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re National Penn Bank

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Serial No. 75/486,503

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John F. A. Earley, John F. A. Earley III and Joseph M. Konieczny of Harding, Earley, Follmer & Frailey for National Penn Bank

Craig D. Taylor, Managing Attorney, Law Office 111

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Before Seeherman, Hanak and Hohein, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

National Penn Bank has appealed from the final refusal of the Trademark Examining Attorney[1] to register DEBT RESOLUTION as a mark for

> banking services, namely, negotiating payoffs of current debt obligations of debtors for less than the outstanding balance and lending money to debtors to permit debtors to satisfy the current

[1] It is noted that this application was examined by the Managing Attorney for Law Office 111. However, because he was acting in his capacity as an Examiner of Trademarks, we have referred to him as a Trademark Examining Attorney in this opinion.

> debt obligations by paying the negotiated payoff, and other consumer/debtor financial counseling services.[2]

Registration was finally refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its identified services.

Both applicant and the Examining Attorney have filed briefs; an oral hearing was not requested.

Before turning to the substantive issue, we must address a procedural point. Applicant has asserted that the final refusal which issued on May 17, 1999 was premature and improper because the Examining Attorney, for the first time in that action, submitted evidence with respect to the descriptiveness of applicant's mark. Applicant's position is incorrect. Trademark Rule 2.64(a) provides that on the first (or any subsequent) reexamination or reconsideration the refusal of the registration may be stated to be final. In the first

[2] Application Serial No. 75/486, filed May 18, 1998, asserting a bona fide intention to use the mark in commerce. It is noted that although the application and drawing identified the mark as DEBT RESOLUTION, it was erroneously entered into the Office's computerized records as DEBT RESOLUTIONS (with the word "resolution" in the plural form). Subsequent papers filed by both applicant and the Examining Attorney have used this erroneous term in their headings. This will clarify that the mark is, in fact, DEBT RESOLUTION, and Office records will be corrected to reflect this.

Office action the Examining Attorney refused registration on the ground that applicant's mark was merely descriptive of its identified services; applicant responded to that refusal; and in the second Office action the Examining Attorney made final the refusal on this same ground. Therefore, the final refusal was not premature. See TBMP § 1201.02. Moreover, applicant has pointed out that in response to its request for reconsideration the Examining Attorney, in maintaining the final refusal, made of record additional evidence "to which applicant was once again not given an opportunity to respond." Brief, p. 3. To the extent that applicant is suggesting that it was improper for the Examining Attorney to submit evidence in responding to a request for reconsideration, applicant is referred to TBMP § 1207.04: "When a timely request for reconsideration of an appealed action is filed (with or without new evidence), the Examining Attorney may submit, with his or her response to the request, new evidence directed to the issue(s) for which reconsideration is sought."

This brings us to the ground for refusal. A term is merely descriptive, and therefore prohibited from registration by Section 2(e)(1) of the Act, if it immediately conveys information concerning a quality,

characteristic, function, feature, composition, purpose, attribute, etc. of a product or service. **In re Engineering Systems Corp.**, 2 USPQ2d 1075 (TTAB 1986); **In re Venture Lending Associates**, 226 USPQ 285 (TTAB 1985). It is sufficient if it describes a single, significant quality, feature, function, etc. Moreover, the question is not decided in a vacuum but in relation to the goods on which, or the services in connection with which, it is used. Id.

We affirm the refusal of registration.

The dictionary definitions submitted by the Examining Attorney show that "debt" is "something owed, such as money, goods or services"; "an obligation or liability to pay or render something to someone else."[3] The Examining Attorney has also asserted that "resolution" means "a resolving of something," although our review of the dictionary definitions submitted reveals that the definition is actually "a resolving to do something." However, we take judicial notice of the following dictionary definitions of "resolution":[4] "the act of

[3] The American Heritage Dictionary of the English Language, 3d ed. © 1992.

[4] The Board may take judicial notice of dictionary definitions. **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

solving";[5] "a solution, accommodation, or setting of a problem, controversy, etc."[6]

When the two words, "debt" and "resolution" are joined in the phrase DEBT RESOLUTION, the clear meaning of these words, as used in connection with the services of negotiating payoffs of debt obligations of debtors and lending money to debtors to satisfy their debt obligations, is that the services provide consumers with a solution to their payment obligations. As such, it immediately conveys information about the purpose of applicant's services. Consequently, the term DEBT RESOLUTION must be considered merely descriptive of the identified services.

In reaching this conclusion we have given little weight to the NEXIS evidence submitted by the Examining Attorney. Many of the excerpts appear to be wire service reports, and in particular reports by foreign wire services, and therefore we have no information as to whether there has been any public exposure to them in the United States. Of the articles which did appear in print, most are from foreign periodicals, e.g., "Asia Pulse," "The Jakarta Post," and again there is no indication of any

[5] Webster's Third New International Dictionary, unabridged © 1993.
[6] The Random House Dictionary of the English Language, 2d ed. unabridged © 1987.

exposure to them by consumers in the United States. It must be remembered that applicant's identified services would be offered to members of the general public who have debt problems, not to sophisticated investors who might read financial news reports in foreign publications. Of the few articles which can be deemed to have circulation in the United States, we agree with applicant that they do not use the term "debt resolution" in connection with the debt negotiating and lending and financial counseling services identified in applicant's application.[7]

Although the Examining Attorney did not submit any articles which show the phrase "debt resolution" used in connection with debt negotiation and lending services of the type identified in applicant's identification, this may be explained by the fact that "applicant believes that its services are novel to the financial world and thus could not have been commonly described using applicant's mark DEBT RESOLUTIONS." Brief, p. 9.

Applicant also argues that DEBT RESOLUTION does not describe its services with particularity in that one would

[7] For example, the May 3, 1999 "Business World" article, about Asia recovery, discusses "strengthening of corporate governance systems and reducing barriers to competition, strengthening bankruptcy laws and debt resolution practices,…."; the April 26, 1999 "BusinessWorld" article states that the SEC and USAID "signed recently a pact to jointly improve the country's debt resolution systems and practices."

not understand from the mark "(1) that applicant negotiates a payoff or reduced amount of a current debt between the creditor and debtor; (2) that applicant lends money to the debtor; (3) that applicant provides consumer/debtor financial counseling; or (4) that applicant is merely brokering these services between debtors and creditors and is not, in fact, either the creditor or debtor." Brief, p. 5.[8] However, in order for a mark to be found merely descriptive it does not have to describe every characteristic, feature, etc. of a product or service. **In re Venture Lending Associates**, supra. Here, the mark immediately and directly conveys information about a significant aspect of applicant's services, namely, the purpose of the services, and therefore it is merely descriptive of them.

Decision: The refusal of registration is affirmed.

E. J. Seeherman

E. W. Hanak

G. D. Hohein
Administrative Trademark Judges
Trademark Trial and Appeal Board

[8] With respect to applicant's fourth point, it would appear that applicant's services, as identified, would include the lending of money to debtors to permit them to satisfy the current debt obligations, and therefore applicant would be, in this respect, a creditor.